

II. REMARKS

1. Claims 1, 2, 5, 9-11, 15-17 are not unpatentable under 35 U.S.C. §103(a) over Ryan Jr., US Patent 6,081,795, hereinafter known as "Ryan" in view of Kara, US Patent 5,822,739 and in further view of document labeled Hauppauge WinCast/TV Card" hereinafter known as "Amato," an article "Toshiba Introduces Home PC Vision Connect For Easy Connection To a TV" hereinafter known as "Toshiba" and Kohorn, US Patent 5,128,752.

Claims 1 and 2 are directed to printing postal indicia at more than one location. The customer station comprises "a television, a set-top box communicatively coupled with the television, a remote control communicatively coupled with the set-top box, and a printer communicatively coupled with the set-top box, said printer disposed to print labels." These features are not disclosed or suggested by the combination of references cited by the Examiner.

Applicants' invention is directed to printing postage indicia in a home or small office with the use of a television set-top box or web television interface. The system of Applicant's invention brings the ability of printing postage stamps on label stock (page 3, lines 9-11). None of the references, either alone or in combination, teach these aspects of Applicant's invention.

Both Ryan and Kara deal with more traditional versions of postage metering systems, albeit one is for a network and one is for remote processing. Amato and Toshiba relate solely to connecting a PC to a TV, and do not relate to postage meter systems. Kohorn is not related to postage metering, but rather the generation of coupons and tokens. The combination of these references does not

even remotely suggest obtaining postal indicia, as recited in claim 1, using a television and set-top box and printing the indicia on labels.

In Ryan, all the meters in a mailroom are on a network. This allows postage that is dispensed from one meter to be printed from a mailing machine other than the one to which it is attached (Col. 1, lines 57-61). So if one meter in the network fails, postage can still be obtained from any other meter on the network. Any mailing machine on the network may obtain postage from any meter (Col. 1, lines 63-68).

The client module 20 of Ryan are digital printers that are dedicated to printing postage indicium and meter or PSD related information (Col. 4, lines 14-17). Each Client Module resembles a conventional digital metering system with optional display, keyboard, and printer 22 (Col. 4, lines 17-20). The client module 20 of Ryan is unlike the "set-top box" described and claimed by Applicants.

First, Applicants respectfully traverse the Examiner's taking of "Official Notice" that one would put the "box on top of some device and call it a set-top box." A "set-top box" has a known meaning. Referring to Newton's Telecom Dictionary, 18th Edition 2002, a "set-top box" is defined as an "electronics box which sits on top of your TV, connecting it to your incoming CATV or MMDS (Microwave Multi-Point Distribution System) TV signal and your TV's incoming coaxial cable." Set-tops, or converter boxes, vary greatly in their complexity, with older models merely translating the frequency received off the cable into a frequency suitable for the television receiver while newer models can be addressable with a unique identity much like a telephone or a node on a computer network." (Id. at 662)

Ryan does not disclose or suggest anything of the sort. The customer station or client module 20 as described above includes a variety of client functions, which are much more than the television set-top box claimed and described by Applicants. The Examiner equates the customer station of Ryan with a "desktop box" (page 3 of Action). However, Ryan discloses much more equipment in this regard and it is a significant oversimplification, misreading and misinterpretation of both Ryan and Applicants' invention to suggest that the "customer station" can be reduced to a "box" which can be placed on "top of some device" and for that reason called a "set-top box." As noted above, the term "set-top box" has a much more technical definition and cannot be reduced simply to a "box on top of some device." Also, as described in Applicants' disclosure, the term "set-top box" does not literally require location on top of the television set. Rather, as detailed by Applicant, the box permits connection between a conventional broadcast television and enhanced services (page 6, lines 19-24). In Applicants' invention, the "customer station" includes the set-top box 70, printer 81, television 88 and remote control 88. Neither Ryan nor Kara disclose or suggest a television and a set-top box communicatively coupled with the television, a remote control communicatively coupled with the set-top box and a printer communicatively coupled with the set-top box.

Kara is directed to remote postage metering. The user inputs a request for the postal indicia into a local system. The request is assembled and transmitted to a remote postage-metering device. Upon verification, a data packet representing the postage indicia is transmitted to the local system for printing (abstract). The combination of Ryan and Kara does not disclose or suggest a customer station comprising a television and a set-top box as

described and claimed by Applicant. Rather, all that Kara and Ryan will allow you to do is generate a request for postal indicia that can be passed to an available PSD in the network. There is nothing in either Ryan or Kara to even remotely suggest printing postage indicia with the use of a television set-top box as is described and claimed by Applicant. In both Ryan and Kara, the client module or station is described in typical fashion, display, keyboard, and printer (Ryan, Col. 4, lines 17-22; Kara, Col. 6, lines 44-58). Neither of these references even remotely suggests the set-top box of Applicants' invention.

Amato does not overcome the deficiencies noted above. The WinCast / TV card appears to allow a computer to be hooked to a TV, although it is respectfully submitted that the precise nature of the device is nebulous. It seems more adapted to allow video to be inputted to the TV. "Make sure you go into the TV program or change it to other video source first and exit." Amato does not discuss a set-top box as claimed and described by Applicants.

It is also respectfully submitted that Ryan, Kara and Amato are being combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case Ryan, Kara and Amato are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Ryan and Kara, nor Amato are in the same field as Applicants' invention. Applicants' invention is directed to using a television and television set-top box to order postal

indicia. Ryan and Kara are limited to obtaining postage from a traditional postage machine system, even if somewhat remotely or via a server. Amato is directed to feeding video from a computer to a TV. Amato is not even remotely related to printing postage via a television. Since Amato does not address any of the problems faced by Applicants, and is not related to Applicants' field of endeavor, printing postage, Amato is not analogous art and may not be properly combined with Ryan and Kara for purposes of 35 U.S.C. §103(a). It is respectfully submitted that the Examiner is using hindsight knowledge of Applicants' invention to try to piece portions of references together to achieve Applicants' invention. This is impermissible.

It is also submitted that there is no motivation to combine Ryan, Kara and Amato. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings.

There is no such suggestion in any of the references. None of the references even remotely suggests using a television and set-top box to print postage. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Ryan, Kara or Amato. The reference itself and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the reference as proposed for purposes of 35 U.S.C. §103(a). When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir.

1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the reference. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Ryan, Kara and Amato under 35 U.S.C. §103(a) is not established.

Toshiba does not overcome the above-noted deficiencies of Amato. Toshiba is also non-analogous art and there is not motivation to combine Toshiba in the manner proposed to achieve Applicants' invention. Toshiba does not disclose or suggest generating postage using the "Vision Connect." It is merely a "multimedia home PC" that takes advantage of the quality of the TV screen.

The Examiner is requested to support, with factual evidence, the Official notice that "placing order for a product (e.g. pay-per-view event) using a remote controller commercially available" at the time of Applicants' invention.

The Examiner is requested to provide support for the "Official Notice" that when a customer places an order from a pay-per-view product, message is passed to the host, processed, and the product is transmitted to the device from where the order was placed, and presented on the presentation device to automate the creation and delivery of the production, at the time of Applicants' invention. The Examiner's positions on the foregoing points is respectfully traversed.

Ryan in view of Kara discloses absolutely nothing related to web television. Ryan uses modems or internet connection to access the data center (Col. 2, lines 32-34). Kara has nothing to do with television or web television information streamed/broadcast over the internet and displayed over the television. Kara merely relates to a remote request for postage, inputted into a local

processor based system (see Abstract, Col. 6, lines 44-46, and FIG. 1). There is absolutely no disclosure that this "local processor system" might be a television or set-top box.

Kohorn does not overcome the deficiencies of Ryan. First, Kohorn has nothing to do with postal indicia. In Kohorn, only tokens and coupons are generated. (Abstract, lines 1-2). The tokens or coupons then need to be "redeemed" at a "redemption facility" to effectuate any "value" of the token. (Col. 1, lines 60-63 and Col. 2, lines 25-26). This is quite different from Applicants' invention where the postal indicia, when printed, has an associated value, and "redemption" at a "redemption facility" is not required. Furthermore, in Kohorn, the consideration of an authenticated token is, after redemption, then made available upon purchase of the product. In Applicants' invention, the customer station requests the postal indicia, which is eventually communicated to the customer station. The postal indicia, when communicated has a "postage value" as recited in claim 1. Thus, this aspect of Applicants' invention is neither disclosed nor suggested by Kohorn, or the combination of Ryan and Kohorn.

Furthermore, in Kohorn, the program signals having product information are transmitted to the remote locations. (Col. 2, lines 1-10). The product must be displayed to the user, who can, at the time the information is displayed, select a product of interest. (Col. 7, lines 59-61). Kohorn makes no mention of a user submitting a request for a specific product without some prompt, such as the information being displayed. In Applicants' invention, the user initiates the request without such prompting. Thus, Kohorn does not disclose or suggest this feature of Applicants' invention. As noted above, Ryan also does not

disclose or suggest at least this feature, so the combination cannot as well.

Kohorn also does not disclose or suggest accounting means as recited by Applicants in claim 1. In Kohorn, as discussed above, the tokens or coupons have no value until they are presented for redemption at a redemption center. Kohorn does not disclose or suggest storing information indicative of postage "value" printed at a customer station as is claimed by Applicants.

Kohorn also does not offer the requisite suggestion or motivation to modify Kohorn in view of Ryan to achieve Applicant's invention. Kohorn is directed to coupons and tokens that have no value, unlike postal indicia. There is no disclosure in Kohorn related to printing a coupon with an associated value. Perhaps it can be said that with "hindsight" of Applicants' invention, one might be motivated to alter Ryan in view of Kohorn to achieve Applicants' invention. However, the use of such hindsight is improper, and the suggestion or motivation to combine or modify the references must be found in the references themselves. It is respectfully submitted that it is not. Thus, Kohorn is not an appropriate reference for purposes of 35 U.S.C. §103(a) and even if combinable, the combination does not disclose or suggest each feature of Applicants' invention.

Similarly, Kohorn is not in the same field of endeavor as Applicants' invention and is not reasonably pertinent to the particular problem with which the Applicants were concerned and is thus non-analogous art for purposes of 35 U.S.C. §103(a). The Applicants were concerned with printing postal indicia on mailpieces and the ability to order or request postal indicia using a set-top box attached to a television set. Kohorn is not reasonably pertinent to that problem. Kohorn has nothing to do

with postal indicia. In Kohorn, only tokens and coupons are generated. (Abstract, lines 1-2). The tokens or coupons then need to be "redeemed" at a "redemption facility" to effectuate any "value" of the token. (Col. 1, lines 60-63 and Col. 2, lines 25-26). This is quite different from Applicants' invention where the postal indicia, when printed, has an associated value, and "redemption" at a "redemption facility" is not required. Furthermore, in Kohorn, the consideration of an authenticated token is, after redemption, then made available upon purchase of the product. In Applicants' invention, the customer station requests the postal indicia, which is eventually communicated to the customer station. The postal indicia, when communicated has a "postage value".

Furthermore, in Kohorn, the program signals having product information are transmitted to the remote locations. (Col. 2, lines 1-10). The product must be displayed to the user, who can, at the time the information is displayed, select a product of interest. (Col. 7, lines 59-61). Kohorn makes no mention of a user submitting a request for a specific product without some prompt, such as the information being displayed. In Applicants' invention, the user initiates the request without such prompting. Thus, although Kohorn may use a set-top box to generate coupons or tokens, these coupons and tokens are nothing like postal indicia, and Kohorn does not even suggest that a secure transaction, which is needed for postal indicia generation, could take place.

Thus, Ryan and Kohorn do not address the problems addressed by Applicants' invention, are not in the same field of endeavor as the Applicants' invention and are not reasonably pertinent to the particular problem with which the Applicants were concerned,

Pursuant to the provisions of 35 U.S.C. §103(a), Ryan and Kohorn are not analogous art and may not properly be combined to establish a *prima facie* case of obviousness. Claim 1 should thus be allowable.

Claims 5, 9-11 and 15-17 should at least be allowable in view of their dependencies on claim 1.

With regard to claim 9, in Kara the balance is coupled to the PC. Kara does not relate to TV or set-top boxes. Thus, there is no motivation or disclosure to connect a scale to a TV set-top box for the purpose of printing postage. This is again the application of hindsight knowledge, which is impermissible. Furthermore, in Applicants' invention, the mass information is transmitted from the weight scale through the set-top box back to the host to determine the indicia. In Kara, the weight of a postal item is inputted into the Demand program (Col. 5, lines 25-28). In Kara, PC 20 is utilized to implement the Demand program (Col. 6, lines 46-48). This is different from Applicants' invention and claim 9 should be allowable.

2. Claims 6 and 7 are not unpatentable over Ryan, Kara, Amato, Toshiba, Kohorn and Breault, US Patent No. 4,941,091 ("Breault") under 35 U.S.C. §103(a). With regard to the rejection of claims 6 and 7, Applicants again reassert that Ryan, Kara, Amato, Toshiba and Kohorn are not combinable for purposes of 35 U.S.C. §103(a) for the stated reasons. Applicants' also respectfully traverse the Examiner's taking of Official Notice, at the time of Applicants' invention. Claim 6 recites that a postage submenu can be called up on a display of the television to allow the user to enter identification data associated with the request for postal indicia. Nothing in Ryan, Kara, Amato, Toshiba or Kohorn discloses or suggests these features.

Breault is similarly not combinable and there is no motivation to combine Breault. Breault also makes no disclosure related to displaying a submenu on a television screen related to postage. Furthermore, it is the "transaction record" that is stored in Breault (see Abstract). There is nothing to suggest a submenu that "prompts" the user for an input, such as identification data, and certainly not a submenu displayed over a television. Breault deals with providing "user defined mailing transaction data collection and reporting." (Col. 1, lines 6-11). This is not the same as prompting the user to enter identification data "associated with the request for postal indicia." Thus, claims 6-7, which should be allowable at least in view of their dependency on claim 1, are not disclosed or suggested.

Merjanian does not overcome the deficiencies of Ryan, Kara, Amato, Toshiba or Kohorn as it relates to claim 12.

In Applicants' invention the fingerprint reader authenticates the reader to the host. In Merjanian, the fingerprint signal is conveyed to the set-top box where any comparison is made (Col. 3, lines 31-39). The storage means is also "within" the set-top box (Col. 3, lines 47-49). Thus, claim 12 cannot be disclosed or suggested by Merjanian and the cited combination of references.

3. Claims 13-14 are not unpatentable under 35 U.S.C. §103(a) over Ryan in view of Kara in further view of Amato, Toshiba, Kohorn, Solondz et al, US Patent 5,602,742, hereinafter known as "Solondz" and Price Watch Corporation hereinafter known as "PriceWatch."

Claims 13 and 14 should at least be allowable in view of their dependency from claim 1.

Also, Solondz does not disclose or suggest transmitting price comparison information to the television display. Rather specific amounts of postage from specific vendors can be purchased (Col. 7, lines 10-66). Nothing in Solondz relates to using a television and set-top box to compare and print postage.

PriceWatch is also non-analogous art since it has nothing to do with obtaining and printing postage as claimed by Applicants. PriceWatch does not disclose or suggest that the host is "linked" to delivery service providers or that the information retrieved is related to the request. On PriceWatch the database is updated periodically (Page 2, first paragraph). Thus, price comparisons may not be accurate (Third paragraph). This is not the same as Applicants' invention where the comparison information is retrieved in real-time.

With regards to claims 3 and 4, the same objections with respect to Ryan and Kara are again renewed.

Comstar is merely a fax modem. Comstar does not even remotely suggest printing postal indicia.

Furthermore, Comstar makes no mention of disclosure of connecting a "set-top box" as that term is defined in the art, to its product. ComStar is limited to the personal computer. Thus, it would not be obvious to modify ComStar for use with a set-top box and television to obtain postal indicia.

4. Claim 19 is not unpatentable under 35 U.S.C. §103(a) over Ryan in view of Kara and in further view of Kara, US Patent 5,801,944, hereinafter known as "Kara2."

Applicants respectfully traverse the Examiner's taking of Official Notice that it would be obvious from Solondz to retrieve

a price from a plurality of carriers to be able to compare prices, and request evidence of same. Solondz allows the purchase of postage through a clearing house 62 which, in turn, interfaces with various postal / carrier services 64, 66 and 68 (Col. 9, lines 46-51). The clearinghouse 62 can download current rate table information (Col. 9, lines 64-66). There is no disclosure in Solondz related to a user entering a request for delivery rates for an item and having the host data center solicit "quotes" from each delivery service provider and then provide the "quotes" to the user. Solondz merely suggests the use of a "postage rate database" (Abstract). However, this is not the same as, and does not make obvious the ability to "solicit quotes" from each delivery service. PriceWatch does not overcome these deficiencies, nor does it in any way make it obvious to "solicit" and "provide" the "quotes" to the user. PriceWatch stores data fed to it from the reseller. PriceWatch is "researched" pricing information. PriceWatch cannot "solicit" a quote as claimed by Applicants, nor can it "provide" a "quote" to a user. Significantly, PriceWatch on page 3 or 19 states,

"Why is it that when I call a dealer about a price, sometimes it is different from what you quote for them on your service?' Prices on certain items can fluctuate by the day or even hour. We do our best to keep up. Rule of thumb - use our service as a guide and not cold fact."

Thus, quite simply stated, PriceWatch is not a quote as described and claimed by Applicants. Thus, claim 19 should be allowable. Applicants also reassert the arguments previously presented related to the use of this reference for purposes of 35 U.S.C. §103(a).

5. Claims 8 and 20 are not unpatentable under 35 U.S.C. §103(a) over Ryan in view of Kara and in further view of Amato, Toshiba, Kohorn and Kara2.

Claim 8 should be allowable at least in view of its dependency on claim 1.

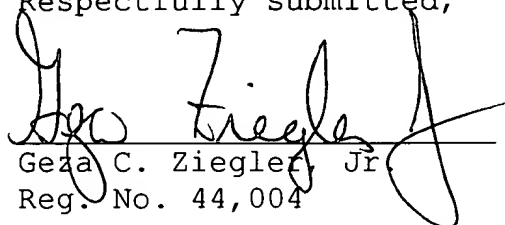
Claim 20 is not disclosed or suggested because neither Ryan nor Kara teach a "television based communications interface" that allows cryptographically secure postal indicia to be received from the host data center at the customer site.

The previous arguments related to the combinability and use of Ryan, Kara, Toshiba and Kohorn are again reasserted here. Neither Ryan nor Kara relate to a television or set-top box. Thus, there is no motivation and it would not be obvious to combine those references with any of Amato, Toshiba, Kohorn or Kara2 to achieve Applicants' invention. Thus, claim 20 should also be allowable.



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Respectfully submitted,


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